

REMARKS

This is in response to the non-final Official Action currently outstanding with regard to the above-identified application.

At the outset, Applicants wish to thank the Examiner for the courtesy accorded to their undersigned representative during a telephone interview conducted in regard to the above-identified application on January 10, 2007. During that interview, the currently outstanding Official Action, the cited references, a draft of the foregoing Amendment and the following arguments were discussed. It is Applicants' representative's understanding that it was agreed that the foregoing Amendment overcomes the currently outstanding rejections based upon the art currently of record in this application, provided that Applicants can provide citations from the present specification to support the proposition that "the data preparation means prepares **"different"** identification data that uniquely identifies the operation data in each instance of outputting". Further, it is Applicants' representative's understanding that the Examiner has reserved his right to further consideration and/or search concerning this application as hereinabove amended.

Claims 1-28 are pending in the above-identified application. Claims 7, 9, 11, 13, 15, 17, 19, 21, 23, 25, 27, and 28 stand withdrawn from further prosecution in the above-identified application. Claims 1, 22, 24 and 26 have been amended. New claim 29 has been added. Applicants do not propose the cancellation or the withdrawal of any claims. Accordingly, upon the entry to the foregoing Amendment, Claims 1-6, 8, 10, 12, 14, 16, 18, 22, 24, 26 and 29 as hereinabove amended will constitute the claims under active prosecution in this application.

The claims of this application as they will stand upon the entry of the foregoing Amendment are set forth above including appropriate status identifiers as required by the Rules.

More specifically, in the currently outstanding Official Action the Examiner has:

1. Failed to re-acknowledge Applicants' claim for foreign priority under 35 USC §119 (a)-(d) or (f), and to reconfirm the receipt by the United States Patent and Trademark Office of the required copies of the priority documents; -
These matters were acknowledged in a previous Official Action and are referred to here solely for the sake of clarity in the record.
2. Failed to comment upon the acceptability of the drawings – **It is noted that the Examiner indicated in a previous Official Action in the above-identified application that the drawings as filed with this application on 1 August 2001 stand accepted. Accordingly, this matter also is mentioned here solely for the sake of clarity in the record;**
3. Acknowledged Applicants' Information Disclosure Statements of 16 August 2006 and 21 August 2006 by providing Applicants with copies of the Forms PTO/SB/08a/b that accompanied those Information Disclosure Statements duly signed, dated and initialed in confirmation of the Examiner's consideration of all of the references listed therein.
4. Rejected claims 1-6, 8, 10, 12, 14, 16, 18, 22 and 24 under 35 USC §103(a) as being unpatentable over the Mazzagatte et al. reference (US Patent 6,862,583) in view of the Francis et al. reference (US Patent 6,650,430);
5. Rejected claim 20 under 35 USC 103(a) as being unpatentable over the Mazzagatte reference in view of the Francis reference further in view of Reilly reference, further in view of the Peters reference (US Patent 6,601,093), and

6. Rejected claim 26 under 35 USC 102(e) as being anticipated by the Mazzagatte et al reference.

Further comment regarding items 1-3 above is not deemed to be required in these Remarks.

With regard to items 4-6, on the other hand, Applicants note that the Examiner has taken the position that several of the features upon which reliance has been placed during the course of this prosecution are not recited in the rejected claims. Specifically, in response to Applicants' Arguments in the currently outstanding Official Action, the Examiner has stated that:

Applicants' arguments with respect to claims 1-6, 8, 10, 12, 14, 16, 18, 20, 22, 24 and 26 have been considered but are moot in view of the new ground(s) of rejection. Applicants argued that:

(1) Mazzagatte does not teach, disclose or suggest the storage of identification data that uniquely identifies operation data in the small card (Remarks filed 8/21/2006). By identifying an intended recipient, the Mazzagatte identification information non-uniquely identifies the recipient of a particular print job because any/all print jobs that are/is intended for that recipient are identified by the Mazzagatte identification information (Remarks filed 4/14/2006).

In response, Mazzagatte teaches of a smart card containing unique identification data **of a recipient** (Col. 9, lines 52-55). The identification data **of the recipient** is compared to identification information stored in the print queue and is used to determine print jobs **intended for the recipient** (Col. 10, lines 15-20). Thus, the identification data uniquely identifies the operation data, i.e., the print job, of the recipient, from operation data, i.e., print job, of others in the printer queue. (Emphasis added)

The features of identifying a particular print job or any/all print jobs which Applicant argued that Mazzagatte does not teach, are not defined in the claims. The claims merely recited of identification data that uniquely identifies operation data. Examiner respectfully notes that these features upon which Applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Guens*, 988 F. 2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)

Applicants do not agree with the just quoted position of the Examiner because Applicants believe that “data preparation means for preparing operation data and identification data uniquely identifying the operation data” as previously recited in Claim 1, for example, unambiguously defines a situation wherein each generated operation data is provided with its own identification data that is different from the identification data that may be associated with other operation data. Thus, it has been, and remains, Applicants’ position that the claims of this application as they stood prior to the foregoing Amendment clearly, definitely and unambiguously defined the situation wherein each generated operation data was provided with its own distinct and separate identification data, not the situation wherein each operation data of a recipient is associated with the same identification data designating the recipient. In other words, the claims as previously written specifically called for each operation data to be associated with unique identification data, not that all of the operation data of a particular recipient was to be associated with a unique identification data representing that recipient (i.e., all operation data of the recipient associated with the common, not unique, identification data of the recipient). Hence, Applicants believe that the Examiner improperly has read limitations into the claims of this application that were not in fact present therein.

Despite the foregoing, and in the interest of advancing this application toward allowance, Applicants by the foregoing Amendment have amended all of the independent claims of this application so as to specifically indicate that the data preparation means prepares and outputs the operation data and further that the data preparation means also prepares and outputs different identification data that uniquely identifies the operation data in each instance of outputting. Applicants respectfully submit that the fact that different identification data is associated with each instance of outputting of operation data is fully supported by the present specification among other locations at Page 6, lines 14-23; Page 17, line 9 to page 20, line 16 (particularly, page 19, lines 15-23, referring to the identification data including a user ID and identification data prepared for each print job; and Page 17, lines 9-14, referring to each print data being identified precisely followed by example of types of data that might accomplish that goal that are clearly different from one another within each type listed); and the paragraphs bridging pages 18 and 19 as well as pages 40 and 41.

As so amended, therefore, Applicants respectfully submit that the Examiner's position that the claims of this application allow for all operation data of a recipient to be identified by the same identification data is no longer viable, if in fact it was previously viable. In particular, the claims of this application now have been amended so as to indicate that each time operation data is generated by the data preparation means the data preparation means also generates different identification information that uniquely identifies the operation data so generated. Hence, the same identification data cannot identify more than one operation data in the present invention as now claimed.

Consequently, Applicants respectfully submit that the foregoing Amendment removes the bases allegedly supporting the Examiner's Response to Applicants' Previous Arguments and thereby renders the claims as hereinabove amended patentable for the reasons previously discussed during this prosecution that are repeated hereinbelow for the sake of completeness of the current presentation.

Accordingly, the primary features of the present invention reside in that print data that is commanded by a personal computer or the like to be printed out is held in a storage device associated with the printer without being printed out, and information that uniquely identifies the so held print data is stored in the user's portable storage device. When the user having the data storage device in his possession approaches the target printer, the printer senses the existence of the information uniquely identifying specific print data that is stored in the storage device, and the so identified the print data held in the printer then starts to print out. More specifically, the approach of the user who has a storage device in which the information uniquely identifying the print data in his possession allows the printer to carry out (i) the identifying of the print data, based on information uniquely identifying the print data, stored in the storage device and (ii) the print-out of the print data so uniquely identified.

On the other hand, the primary reference cited by the Examiner is directed to a technique relating to the authentication of a user who can command outputting of print data held by the printer. As such, Applicants respectfully submit that the art cited by the Examiner is totally different from the present invention that specifically includes (i) the technique by which the print data is uniquely identified based on the information identifying the print data, (ii) the technique by which the print data which has been uniquely identified is outputted, and (iii) the printer that carries out the above operation automatically.

Hence, Applicants respectfully submit that with regard to independent Claim 1, for example, it should be noted that the claim recites *inter alia* **different** identification data that uniquely identifies the operation data outputted during each instance of outputting, and portable storage means for receiving the unique identification data. This feature is not taught or suggested by any of the presently cited references.

Further, in an attempt to supply a teaching of the presently claimed portable storage means, the Examiner relies upon the smart card, as taught by the Mazzagatte reference. It is respectfully noted, however, that the smart card of the Mazzagatte reference merely stores **authentication information indicating the user**. There is no teaching, disclosure or suggestion in the Mazzagatte reference regarding the storage of identification data that **uniquely identifies operation data** in the smart card discussed by the Mazzagatte reference.

Further, the Examiner cites the Francis reference as teaching “entering information into the memory of the smart card”, but the smart card of the Francis reference stores only a password and security mark images, not identification data as now herein claimed. Applicants respectfully submit that it is to be recognized that the Francis reference teaches that once the smart card key has been programmed with a password, that password can only be changed under certain selected conditions or circumstances (see column 4, lines 24-28). Accordingly, Applicants respectfully submit that the best that can be said regarding the Examiner’s construction of the Francis reference is that it teaches, discloses or suggests that the changing of information on the smart card should not be easily accomplished.

However, Applicants respectfully submit that in the present circumstances if a job ID is to be stored on the smart card, the information on the smart card would need to be changed for every print job. This clearly would be impractical in the context of printing numerous jobs to the extent that that Applicants respectfully suggest that it is clear that one of ordinary skill in the art at the time that the present invention was made would not have been lead to combine the Mazzagatte and Francis references in order to achieve the result achieved by the present invention.

Rather, it only has been by utilizing the present invention as a basic framework that the Examiner has been able to pick and chose isolated elements of the prior art so as to recreate the present invention. Such clearly is not an acceptable way to establish the *prima facie* case required to justify the Examiner's currently outstanding rejections.

Claims 22, 24 and 26 recite similar features to those just discussed with regard to Claim 1, and Applicants respectfully submit that the Examiner's rejections of those claims must fail for reasons similar to those just discussed with regard to Claim 1.

With respect to claim 20, the Examiner contends that the claimed features are taught by a combination of the Mazzagatte reference and the Peters reference. Applicants respectfully submit in this regard, however, that the Peters reference merely describes a wireless notebook computer that transmits data to a printer. Accordingly, one skilled in the art desiring to apply the Peters teachings to the device disclosed by the Mazzagatte reference would replace the laptop computer 20 of the Mazzagatte reference with the wireless computer of the Peters reference since the wireless computer of the Peters reference would be performing a similar function to that of the laptop computer of Mazzagatte. However, Applicants respectfully submit that such a substitution has nothing at all to do with the leading one of ordinary skill in the art to replace the smart card of the Mazzagatte reference with the wireless computer of the Peters reference.

Furthermore, the Examiner relies on the Peters reference as providing a teaching of the transmitting of information to a printer. In this regard it will be seen that the Peters reference describes two embodiments, namely, (1) a wireless computer establishing communications with a printer directly (without transmitting the information to a server) and (2) a wireless computer establishing communications with a server (see, Peters at Column 4, lines 41-50).

However, a wireless computer establishing a communications with a server does not correspond to a wireless device transmitting information to a printer and thus cannot support the Examiner's position. Further, a wireless computer establishing communications with a printer directly is not compatible with the Mazzagatte reference.

The Mazzagatte reference requires that print data be stored on a print node (a server) until authentication is received (see Mazzagatte, Column 2, lines 13-20, for example). However, the combination proposed by the Examiner would require print data to be sent directly to the printer from the wireless computer, contrary to the express teachings of the Mazzagatte reference. Accordingly, Applicants respectfully submit that the combination of the Mazzagatte and Peters references is not suggested to one skilled in the art as the Examiner has asserted.

Still further and also contrary to the Examiner's assertions in the currently outstanding Official Action, Applicants respectfully submit that the art relied upon in support of the currently outstanding rejections does not teach, disclose or suggest that the identification data is transmitted automatically from a portable data storage device when the portable data storage device approaches the claimed electronic device. Instead, in both the Mazzagatte and Francis references, the potential user of the printer is required to actively associate the so-called "small card" with the CPU controlling the operation of the printer. In other words, the user has to insert his "small card" into a small card reader and survive a so-called "challenge/response" sequence prior to the input of the identification information thereon acting to cause the printing of anything. This appears to be true no matter what the proximity relation of the small card reader to the printer may be (note, nothing in the references appears to require that spatial relationship between the small card reader and the printer to be a close). The same is true even if the small card transmits its signals via RF instead of being plugged into the small card reader.

Applicants therefore respectfully submit that the Examiner has not satisfied his burden of showing a valid *prima facie* case in support of his assertions that the claims of this application are unpatentable. Accordingly, Applicants respectfully submit that as hereinabove amended the claims of this application now are in condition for allowance. Therefore, entry of the foregoing Amendment and reconsideration and allowance of the present application in response to this communication are respectfully requested

Applicants believe that additional fees are not required in connection with the consideration of this response to the currently outstanding Official Action. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge and/or credit Deposit Account No. **04-1105**, as necessary, for the correct payment of all fees which may be due in connection with the filing and consideration of this communication.

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Respectfully submitted,

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